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In re: Pharma Mar, s.a. et al. :DECISION ON REQUEST
Serial No.: 09/787461 :UNDER 37 CFR 5.25
Petition Filing date: March 2, 2001
Docket No.: 4512/80212

Title: COMPOSITIONS AND USES OF ET743 FOR TREATING CANCER

This is a decision on the petition filed March 2, 2001 for retroactive foreign filing license.

Decision: Denied

37 CFR 5.25(a) requires the following:

1. A listing of each of the foreign countries in which the unlicensed patent application material was filed,
2. The dates on which the material was filed in each country,
3. A verified statement (oath or declaration) containing:
 - i. An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order,
 - ii. A showing that the license has been diligently sought after discovery of the proscribed foreign filing, and
 - iii. An explanation of why the material was filed abroad through error and without deceptive intent without the required license under § 5.11 first having been obtained, and
4. The required fee (§ 1.17(h)).

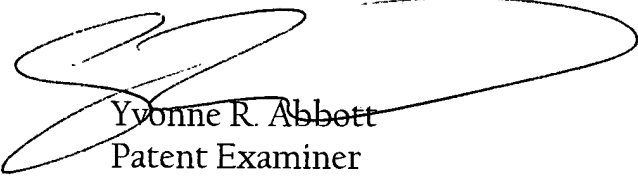
The petition is Denied at this time in that the petition is defective since the requirements set forth in 37 C.F.R. 5.25(a)(3)(ii) and (iii) have not been met.

There appears to be no error as to why the material was first filed abroad. In the declaration of attorney Graham Ruffles, it states in ¶3 that "under UK patent law, there is no requirement to name the inventors". It appears that it was merely reliance on UK law and not lack of knowledge of the requirements of US laws that prevented the legal representatives from conducting a thorough investigation of inventorship. Not determining inventorship until later in the prosecution process

is not within the meaning of "error" as provided in 37 CFR 5.25(a)(3)(iii). A statement clarifying this issue is needed.

Furthermore, with respect to the issue of diligence, there is no explanation as to what the attorney did to pursue discovery of facts, or investigation of inventorship between 5/00 (when the US inventors were known) and the filing of the petition on 3/2/01 (almost a year later).

Accordingly, the provisions of 37 CFR 5.25 not having been fully met, the petition is DENIED, and in the absence of any response within **60 days** of the mailing date of this letter, such denial will be made final and the final action under 35 U.S.C. 185 will be taken. Extensions of time may be had under 37 C.F.R. 1.136(a).



Yvonne R. Abbott
Patent Examiner
(703) 308-2866

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/787,461	12-Oct-01	PHARMA MAR, S.A. ET AL	4512/80212

Title: COMPOSITIONS AND USES OF ET743 FOR
TREATING CANCER

Correspondence Address:

ERNEST V. LINEK
BANNER & WITCOFF, LTD.
28 STATE STREET, 28TH FLOOR
BOSTON, MA 02109

Art Unit	Paper Number
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LICENSING & REVIEW

Please find attached a communication from the Examiner regarding the
Petition for Retroactive License under 37 CFR 5.25.